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EXAMINER

DAZENSKI, MARC A

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/596,283 | Applicant(s) NAKATSU, ETSUTO | |
| | Examiner MARC DAZENSKI | Art Unit 2621 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6-08-06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

Claim 10 is objected to because of the following informalities: line 5 of the claim refers to "the list." However, there is insufficient antecedent basis for this in the claim; the examiner suggests amending this to read "a list." Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-5, 7-8, 11, and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Honjo (US PgPub 2002/0061181), hereinafter referred to as Honjo, in view of Nomura et al (US PgPub 2001/0024562), hereinafter referred to as Nomura.

Regarding **claim 1**, Honjo discloses a method and apparatus for recording/reproduction. Further Honjo discloses a recording/reproduction apparatus for dubbing AV data from an HDD to an optical disk, wherein the data on the HDD is recorded in 9-Mbps CBR/transport stream formats and is then converted to 3-Mbps VBR/program stream formats so as to be dubbed onto an optical disk, which reads on the claimed, "a data processor having ability to write a data stream on each of storage media of first and second types, wherein first and second data streams in mutually

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different formats are allowed to be written on the first type of storage medium, while the second data stream is allowed to be written on the second type of storage medium," as disclosed at paragraphs [0071]-[0073] and exhibited in figure 1; the apparatus comprising:

terminal (22) which receives an inputted video signal in the form of a digital broadcast signal, which reads on the claimed, "a receiving section for receiving the first data stream," as disclosed at paragraphs [0078]-[0079] and exhibited in figure 1;

video coding means (2) and stream converting means (5) which convert the 9-Mbps CBR/TS data on the HDD to 3-Mbps VBR/PS data, which reads on the claimed, "a converting section for converting the first data stream into the second data stream," as disclosed at paragraphs [0072]-[0073], [0081] and [0084];

recording means (7) which records the above mentioned streams onto the HDD, which reads on the claimed, "a processing section for writing the first and second data streams on the first type of storage medium," as disclosed at paragraphs [0072], [0079], and [0084], as well as exhibited in figure 1; and,

video decoding means (11) and reproduction means (10) which read 9-MBps/TS data from the HDD (8) and reproduce it, which reads on the claimed, "a playback section for playing back a content based on the first data stream," as disclosed at paragraph [0072] and exhibited in figure 1.

However, Honjo fails to disclose an instruction receiving section for receiving, from a user, an instruction on whether the content needs to be dubbed or not, wherein if the user has instructed that the content be dubbed, the processing section reads the

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second data stream from the first type of storage medium, writes the second data stream on the second type of storage medium, and then deletes the second data stream from the first type of storage medium. The examiner maintains that it was well known in the art to include the missing limitations, as taught by Nomura.

In a similar field of endeavor, Nomura discloses an information processing apparatus and method as well as program storage medium. Further, Nomura discloses AV contents management search program (82) which controls a display unit (30) to display a copy option setting window (251), which allows a copying of contents recorded on the HDD to be deleted after copied onto the external recording medium which may be an optical disc, which reads on the claimed, “an instruction receiving section for receiving, from a user, an instruction on whether the content needs to be dubbed or not, wherein if the user has instructed that the content be dubbed, the processing section reads the second data stream from the first type of storage medium, writes the second data stream on the second type of storage medium, and then deletes the second data stream from the first type of storage medium,” as disclosed at paragraphs [0104]-[0111] and exhibited in figures 13-16.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method and apparatus for recording/reproduction of Honjo to include AV contents management search program (82) which controls a display unit (30) to display a copy option setting window (251), which allows a copying of contents recorded on the HDD to be deleted after copied onto

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the external recording medium which may be an optical disc, as taught by Nomura, for the purpose of making more efficient use of recording capacity on a recording medium.

Regarding **claim 3**, the combination of Honjo and Nomura discloses everything claimed as applied above (see claim 1). Further, the limitations of the claim are rejected in view of the explanation set forth in claim 1 above.

Regarding **claim 4**, the combination of Honjo and Nomura discloses everything claimed as applied above (see claim 3). Further, the limitations of the claim are rejected in view of the explanation set forth in claim 3 above.

Regarding **claim 5**, the combination of Honjo and Nomura discloses everything claimed as applied above (see claim 3). Further, the limitations of the claim are rejected in view of the explanation set forth in claim 3 above.

Regarding **claim 7**, the combination of Honjo and Nomura discloses everything claimed as applied above (see claim 3). Further, the limitations of the claim are rejected in view of the explanation set forth in claim 3 above (wherein by not selecting the option to copy, this allows the user to decide later whether the contents need to be dubbed).

Regarding **claim 8**, the combination of Honjo and Nomura discloses everything claimed as applied above (see claim 3). Further, the limitations of the claim are rejected in view of the explanation set forth in claim 3 above (wherein by not selecting the option to copy, this allows the user to decide later whether the contents need to be dubbed, and the content therefore remains on the HDD as exhibited in item (204) of figure 13).

Regarding **claim 11**, the combination of Honjo and Nomura discloses everything claimed as applied above (see claim 1). Further, Honjo discloses the streams on the

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HDD (8) are converted from TS to PS, which reads on the claimed, "wherein the first data stream is an MPEG-2 transport stream, and wherein the second data stream is an MPEG-2 program stream," as disclosed at paragraphs [0072] and [0077]-[0084].

Regarding **claims 12 and 14-16**, the examiner maintains that the claims are merely the corresponding method to the apparatus of claims 1 and 3-5, and are therefore rejected in view of the explanation set forth in claims 1, and 3-5 above.

Claims 2 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Honjo (US PgPub 2002/0061181), hereinafter referred to as Honjo, in view of Nomura et al (US PgPub 2001/0024562), hereinafter referred to as Nomura, further in view of well known prior art (see MPEP 2144.03).

Regarding **claim 2**, the combination of Honjo and Nomura discloses everything claimed as applied above (see claim 1). However, the combination fails to disclose wherein if the user has instructed that the content not be dubbed, the processing section deletes the second data stream from the first type of storage medium. The examiner maintains that it was old and well-known in the art to delete a data stream from a storage medium, and therefore takes Official Notice (wherein deleting a data stream from a storage medium is an implicit user instruction to not dub the content).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Honjo and Nomura to include wherein if the user has instructed that the content not be dubbed, the processing section deletes the second data stream from the first type of storage medium, for the purpose of making more efficient use of recording capacity on a recording medium.

Regarding **claim 13**, the examiner maintains that the claim is merely the corresponding method to the apparatus of claim 2, and is therefore rejected in view of the explanation set forth in claim 2 above.

Claims 6 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Honjo (US PgPub 2002/0061181), hereinafter referred to as Honjo, in view of Nomura et al (US PgPub 2001/0024562), hereinafter referred to as Nomura, further in view of Cheng et al (US Patent 7,369,750), hereinafter referred to as Cheng.

Regarding **claim 6**, the combination of Honjo and Nomura discloses everything claimed as applied above (see claim 1). However, the combination fails to disclose wherein unless the content starts to be played back within a predetermined amount of time after the first data stream has been written, the processing section deletes the second data stream. The examiner maintains that it was well known to include the missing limitations, as taught by Cheng.

In a similar field of endeavor, Cheng discloses managing of recorded events. Further, Cheng discloses a program deletion prioritization mechanism for freeing storage space, one of the factors of which is whether the program has been watched or by the age of the recording based on the recording date, which reads on the claimed, “wherein unless the content starts to be played back within a predetermined amount of time after the first data stream has been written, the processing section deletes the second data stream,” as disclosed at column 9, lines 22-48.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Honjo and Nomura to include

a program deletion prioritization mechanism for freeing storage space, one of the factors of which is whether the program has been watched or by the age of the recording based on the recording date, as taught by Cheng, for the purpose of making more efficient use of recording capacity on a recording medium.

Regarding **claim 9**, the combination of Honjo and Nomura discloses everything claimed as applied above (see claim 8). Further, the limitations of the claim are rejected in view of the explanation set forth in claim 6 above.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Honjo (US PgPub 2002/0061181), hereinafter referred to as Honjo, in view of Nomura et al (US PgPub 2001/0024562), hereinafter referred to as Nomura, further in view of Goto et al (US Patent 7,239,796), hereinafter referred to as Goto.

Regarding **claim 10**, the combination of Honjo and Nomura discloses everything claimed as applied above (see claim 1). However, the combination fails to disclose wherein when the remaining capacity of the first type of storage medium becomes equal to or smaller than a predetermined value, the processing section deletes the second data stream representing the content that has been registered on the list. The examiner maintains that it was well known to include the missing limitations, as taught by Goto.

In a similar field of endeavor, Goto discloses an information recording and reproducing apparatus. Further, Goto discloses an automatic program deleting process which repetitively checks the capacity on a HDD and in the case of a shortage of a usable capacity, deletes at least a portion of a program, which reads on the claimed, “wherein when the remaining capacity of the first type of storage medium becomes

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equal to or smaller than a predetermined value, the processing section deletes the second data stream representing the content that has been registered on the list," as exhibited in figure 16 and its accompanying text (column 13, line 34 through column 14, line 61, with particular emphasis on column 14, lines 11-40).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Honjo and Nomura to include an automatic program deleting process which repetitively checks the capacity on a HDD and in the case of a shortage of a usable capacity, deletes at least a portion of a program, as taught by Goto, for the purpose of making more efficient use of recording capacity on a recording medium.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARC DAZENSKI whose telephone number is (571)270-5577. The examiner can normally be reached on M-F, 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on (571)272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Marsha D. Banks-Harold/
Supervisory Patent Examiner, Art Unit 2621

/MARC DAZENSKI/
Examiner, Art Unit 2621